



DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2022-0027]

Expanding Admission Criteria for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Request for comments.

SUMMARY: This request for comments seeks public input on the scientific and technical requirements to practice in patent matters before the United States Patent and Trademark Office (USPTO or Office). Specifically, the Office seeks input on whether it should revise the scientific and technical criteria for admission to practice in patent matters to require the USPTO to periodically review certain applicant degrees on a predetermined timeframe, and make certain modifications to the accreditation requirement for computer science degrees. This request for comments also seeks input on whether the creation of a separate design patent practitioner bar would be beneficial to the public and the Office, whether to add clarifying instructions to the General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases before the United States Patent and Trademark Office (GRB) for limited recognition applicants, and whether the Office should make any additional updates to the scientific and technical requirements for admission to practice in patent matters. The USPTO is undertaking this effort as part of its continual review of the admission criteria for sitting for the registration examination.

DATES: Comment Deadline: Written comments must be received on or before [INSERT DATE 90 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, one should enter docket number PTO-P-2022-0027 on the homepage and click “Search.” The site will provide search results listing all documents associated with this docket. Commenters can find a reference to this notice and click on the “Comment” icon, complete the required fields, and enter or attach their comments. Attachments to electronic comments will be accepted in portable document format (PDF) or DOCX format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of and access to comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: Will Covey, Deputy General Counsel and Director, Office of Enrollment and Discipline (OED), at 571-272-4097 or oed@uspto.gov.

SUPPLEMENTARY INFORMATION:

Summary

In this request for comments, the USPTO seeks feedback and information on revising the scientific and technical criteria to practice in patent matters before the Office, whether the instructions to applicants for limited recognition should be clarified, and whether the Office should establish a separate design patent practitioner bar.

Background

The Director of the USPTO has statutory authority to require a showing by patent practitioners that they possess “the necessary qualifications to render applicants or other

persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.” 35 U.S.C. 2(b)(2)(D). Courts have determined that the USPTO Director bears the primary responsibility for protecting the public from unqualified practitioners. *See Hsuan-Yeh Chang v. Kappos*, 890 F. Supp. 2d 110, 116-17 (D.D.C. 2012) (“Title 35 vests the [Director of the USPTO], not the courts, with the responsibility to protect [US]PTO proceedings from unqualified practitioners.”) (quoting *Premysler v. Lehman*, 71 F.3d 387, 389 (Fed. Cir. 1995)), *aff’d sub nom.*, *Hsuan-Yeh Chang v. Rea*, 530 F. App’x 958 (Fed. Cir. 2013).

Pursuant to that authority and responsibility, the USPTO has promulgated regulations, administered by OED, that provide that registration to practice in patent matters before the USPTO requires a practitioner to demonstrate possession of “the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service.” 37 CFR 11.7(a)(2)(ii).¹ The Office determines whether an applicant possesses the legal qualification by administering a registration examination, which applicants must pass before being admitted to practice. *See* 37 CFR 11.7(b)(ii). To take the registration exam, applicants must first demonstrate they possess specific scientific and technical qualifications. The USPTO sets forth guidance for establishing possession of these scientific and technical qualifications in the GRB, which is available at www.uspto.gov/sites/default/files/documents/OED_GRB.pdf. The GRB also contains the “Application for Registration to Practice before the United States Patent and Trademark Office.”

¹ Legal representation before Federal agencies is generally governed by the provisions of 5 U.S.C. 500. However, that statute provides a specific exception for representation in patent matters before the USPTO. 5 U.S.C. 500(e). *See* 35 U.S.C. 2(b)(2)(D) (formerly 35 U.S.C. 31).

The criteria for practicing before the Office are based in part on a determination of the types of scientific and technical qualifications and legal knowledge that are essential for practitioners to possess. This helps ensure that only competent practitioners who understand the applicable rules and regulations and have the background necessary to describe inventions in a full and clear manner are permitted to practice.

Presently, there is only one patent bar that applies to those who practice in patent matters before the Office, including in the utility and design patent areas. The same scientific and technical requirements for admission to practice apply regardless of the type of patent application (i.e., whether the application is a utility patent application or a design patent application).

Request for Public Comments

The USPTO seeks written comments from the public on the scientific and technical requirements for admission to practice in patent matters, including whether there should be separate requirements for practitioners who intend to only prosecute design patent applications (i.e., whether the Office should establish a separate design patent bar). In addition, the Office seeks comments on whether the instructions to applicants for limited recognition in patent matters should be clarified.

The USPTO welcomes any comments from the public on the proposals covered in this notice as well as responses to specific questions posed at the end of this notice. The Office also welcomes any other comments related to the subject matter of this notice.

Request 1: Require the USPTO to Periodically Review Applicant Degrees and Add Commonly Accepted Category B Degrees to Category A on a Predetermined Timeframe.

The USPTO has evaluated, and continues to evaluate, the scientific and technical qualifications set forth in the GRB. These evaluations seek to clarify guidance on what will satisfy the scientific and technical qualifications and to identify possible areas of improved administrative efficiency.

The GRB lists three categories of scientific and technical qualifications that typically make one eligible for admission to the registration examination: (1) Category A, for specified bachelor's, master's, and Ph.D. degrees; (2) Category B, for other bachelor's, master's, and Ph.D. degrees with technical and scientific training; and (3) Category C, for individuals who rely on practical engineering or scientific experience and have passed the Fundamentals of Engineering test. If an applicant for registration does not qualify under any of the categories listed in the GRB, the USPTO will conduct an independent review for compliance with the scientific and technical qualifications.

Starting in early 2020, the Office undertook a review of Category B applications to identify bachelor's degrees that are routinely accepted as demonstrating the requisite scientific and technical qualifications. In September 2021, the Office added 14 of these degrees, which were previously evaluated under the criteria listed in Category B, to Category A. The review of degrees is ongoing and is currently based on applicant data from those applying for the registration exam. Category A is not an exhaustive list of all degrees that would qualify, and the USPTO's current practice is to accept degrees when the accompanying transcript demonstrates equivalence to a Category A degree (for example, molecular cell biology may be equivalent to biology).

The Office is considering whether, given the fast pace at which technology and related teachings evolve, it should periodically review commonly accepted Category B degrees and add them to Category A. These reviews would seek to clarify guidance on what would satisfy the scientific and technical qualifications, would improve administrative efficiency, and would simplify the application process for aspiring

practitioners. For example, the USPTO could conduct such reviews on a three-year cycle. This timeframe would provide adequate time for the USPTO to gather, review, and analyze the degree data from a sufficient number of applicants for the registration exam. The Office invites comments on the proposed predetermined timeframe and whether the review should be based on any other criteria. If other criteria are suggested, the Office requests detailed information on why the specific criteria are recommended and any data that would be relied on in analyzing the criteria.

Request 2: Modify the Accreditation Requirement for Computer Science Degrees Under Category A to Accept Bachelor of Science Computer Science Degrees.

Currently, under Category A, the USPTO accepts computer science degrees accredited by the Computer Science Accreditation Commission (CSAC) of the Computing Sciences Accreditation Board (CSAB), or by the Computing Accreditation Commission (CAC) of the Accreditation Board for Engineering and Technology (ABET), on or before the date the degree was awarded. Computer science degrees that are so accredited may be found on the Internet (www.abet.org).

The USPTO requests input on whether the accreditation requirement for computer science degrees should be modified to accept under Category A Bachelor of Science degrees in computer science awarded by an accredited United States college or university, regardless of the ABET accreditation status of the program. Under this modification, Bachelor of Arts degrees in computer science may still qualify an applicant to sit for the examination under Category B. The Office requests that any commenters also include the rationale, data, and/or reasons for modifying the requirement.

Request 3: Possible Creation of a Separate Design Patent Practitioner Bar.

The USPTO is considering whether a separate design patent practitioner bar would be beneficial to the public and the Office, along with possible options for creating and implementing it. To that end, the Office requests input on whether a design patent practitioner bar, in which admitted design practitioners would practice solely in design patent matters, should be established. The potential creation of a design patent practitioner bar would not impact the ability of those already registered to practice in any patent matters, including design patent matters, before the USPTO. It would also not impact the ability of applicants who meet the current criteria, including qualifying for and passing the current registration exam, to practice in any patent matters before the Office.

Options for implementing a design patent practitioner bar include requiring design patent practitioner bar applicants to:

- (1) take the current registration examination, but with modified scientific and technical requirements;
- (2) be a U.S. attorney (i.e., an active member in good standing of the bar of the highest court of any State); or
- (3) take a separate design bar examination instead of the current registration examination.

The USPTO seeks input on which of the three options, or combinations of the three options, would be most appropriate for establishing a design patent practitioner bar, including any rationale, data, and specific criteria associated with the recommended option(s). For example, if a commenter recommends a particular option, the Office seeks input on why that option was recommended over the other options; what data the commenter relied on in selecting that option, if any; and what criteria would be appropriate in executing the option. Furthermore, the Office notes that design patent examiners typically have one of the following degrees: industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education. The

Office seeks input on whether design bar applicants should have one of these degrees, or other particular degrees.

Any of the three options presented above could require regulatory, Manual of Patent Examining Procedure (MPEP) and GRB changes; training of the examining corps; updates to information technology systems; and workflow changes within the Office. Depending on the option(s) chosen, timing and costs could vary significantly. Additionally, option (3) would require the creation of an entirely new examination.

The USPTO also requests any additional comments that would be useful in deciding whether to create and implement a design patent practitioner bar, and if so, how it should be implemented. For example, the Office is interested in any additional options not described above, as well as how such options could potentially be implemented, the reasoning for such options, and any data or research the commenter relied on in postulating the options.

Request 4: Clarifying Instructions in the GRB for Limited Recognition Applicants.

The USPTO requests input on whether the following instructions should be added to the GRB to aid limited recognition applicants in applying for recognition. These instructions would not change the process by which applicants for limited recognition apply for recognition. Rather, the Office seeks to clarify the process for applicants. These instructions would be inserted on page 7 of the GRB, under Section E.

E. ELIGIBILITY OF ALIENS: No grant of registration except under 37 CFR 11.6(c). An applicant who is not a United States citizen and does not reside in the U.S. is not eligible for registration except as permitted by 37 CFR 11.6(c). Presently, the Canadian Intellectual Property Office is the only patent office recognized as allowing substantially reciprocal privileges to those admitted to practice before the USPTO. The

registration examination is not administered to aliens who do not reside in the United States.

Limited recognition to practice before the Office in patent matters. An alien residing in the United States may apply for limited recognition to practice before the Office in patent matters pursuant to 37 CFR 11.9(b). To be admitted to take the examination, an applicant must fulfill the requirements as stated above in Section III and 37 CFR 11.9(b), which includes that establishing that such recognition is consistent with the capacity of employment authorized by United States immigration authorities, for example the United States Citizenship and Immigration Services (USCIS), United States Department of State, U.S. Customs and Border Patrol, and the U.S. Department of Labor. The evidence establishing such consistency must demonstrate: (1) the applicant's authorization to reside in the United States, and (2) the applicant's authorization to work or be trained in the United States. It must include a copy of both sides of any work or training authorization and copies of all documents submitted to and received from the immigration authorities regarding admission to the United States, and a copy of any documentation submitted to the U.S. Department of Labor. This may include a complete copy of the application for a particular immigration status, the application for a work or training permit, and/or any approved notices related thereto.

Qualifying documentation should specifically show that the immigration authorities have authorized the applicant to be employed or trained in the

capacity of representing patent applicants before the USPTO by preparing and prosecuting their patent applications. Any approval that is pending at the time the application is submitted will result in the applicant being denied admission to the examination.

A qualifying alien within the scope of 8 CFR 274a.12(b) or (c) is not registered upon passing the examination. Therefore, such qualifying aliens will not be patent attorneys or patent agents. Rather, such an applicant will be given limited recognition under 37 CFR 11.9(b) if recognition is consistent with the capacity of employment or training authorized by immigration authorities. Documentation establishing an applicant's qualification to receive limited recognition must be submitted with the applicant's application.

Request 5: General Request for Additional Suggestions on Updating the Scientific and Technical Requirements for Admission to Practice in Patent Matters.

Lastly, the USPTO invites any additional comments on updating the scientific and technical requirements for admission to practice in patent matters. For example, the Office is interested in any additional suggestions not described above, as well as how such suggestions could potentially be implemented, the reasoning for such suggestions, and any data or research the commenter relied on in postulating the suggestions. When offering suggestions, please reference the applicable rules and/or section in the GRB that may be impacted.

Questions Regarding Admission Requirements to Practice in Patent Matters Before the USPTO

As noted above, the USPTO welcomes comments from the public on proposed updates to the scientific and technical requirements for admission to practice in patent matters. The Office is particularly interested in the public's input on the questions below; commenters can address any or all of the questions or provide additional comments:

1. Should the Office review applicant degrees and add commonly accepted Category B degrees to Category A on a predetermined timeframe, e.g., every three years?
2. Should the Office accept Bachelor of Science degrees in computer science under Category A from an accredited United States college or university regardless of whether the degree program is ABET accredited?
3. Should the Office create a separate design patent practitioner bar, and if so, which option(s) and what criteria should be implemented for its creation?
4. Should the Office add clarifying instructions to the GRB for limited recognition applicants?
5. Should the Office implement any additional updates to the scientific and technical requirements for admission to practice in patent matters, and if so, what should those include?

Katherine K. Vidal,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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